

REMARKS

Claims 1-6, 9-36, and 40-47 remain pending and under examination. Claims 7-8 and 37-39 were previously cancelled. Applicant amends claims 1, 4, 6, 9-13, 20, 21-24, 31, 32, 40, and 41. Support for the amendments may be found in the published application at, for example, paragraphs ¶¶ [0060] - [0062].

Office Action

Applicant respectfully traverses the following rejections:

- (1) rejection of claims 1, 9, 13, 20, 21, 24, 31, 40, and 41 under 35 U.S.C. 112, first paragraph;
- (2) rejection of claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 under 35 U.S.C. 112, second paragraph; and
- (3) rejection of claims 1-6, 9-36, and 40-47 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,536,659 ("Hauser") in view of U.S. Patent Application Publication No. 2002/0178074 ("Bloom").

I. Rejections under 35 U.S.C § 112, first paragraph

In rejecting claims 1, 9, 13, 20, 21, 24, 31, 40, and 41, the Final Office Action alleged that "Applicant's specification provides no teaching or disclosure of 'performing a comparison ... ,' and 'splitting the record ... based on the comparison.'" (emphasis in original). See Final Office Action, pages 3-4. In response, and without conceding to the Final Office Action's allegations, Applicant amends independent claim 1, with similar amendments to independent claims 9, 13, 20, 21, 24, 31, 40, and 41, as indicated herein. Support for these amendments is contained in Applicant's specification at, for example, paragraphs ¶¶ [0060] - [0062]. These amendments overcome the rejection

under 35 U.S.C. § 112, first paragraph, and Applicant requests withdrawal of the rejection.

II. Rejections under 35 U.S.C § 112, second paragraph

In rejecting claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41, the Final Office Action alleged that “step(5) ‘*performing a comparison of a quantity of product included in the second record with a received quantity of product*’ is vague and indefinite because the phrase ‘*a received quantity of product*’ is not a positive[] step which indicates the receiving process.” (emphases in original). See Final Office Action, page 4. In response, and without conceding to the Final Office Action’s allegations, Applicant amends independent claim 1, with similar amendments to independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41, as indicated herein. For example, claim 1 now recites “searching a database of the second system for the pending delivery item using a RAN associated with a product received at a warehouse,” and “determining, based on searching the database, if the quantity of the product associated with the return request included in the second record matches a quantity of the product received at the warehouse.” (emphases added). These amendments overcome the rejection under 35 U.S.C. § 112, second paragraph, and Applicant requests withdrawal of the rejection.

In rejecting claim 1, the Final Office Action alleged that “step (d) ‘*creating a record in a second computer ...*’; step (e) ‘*performing a comparison of a quantity of product included in the second record with a received quantity of product*’ and step (f) recites ‘*splitting the record in the second computer ... based on the comparison*’ is vague and indefinite because it is not clear all of the ‘record’ in these steps are the same ‘record’ or different.” (emphases in original). See Final Office Action, page 5. In

response, and without conceding to the Final Office Action's allegations, Applicant amends independent claim 1 as indicated herein. These amendments overcome the rejection under 35 U.S.C. § 112, second paragraph, and Applicant requests withdrawal of the rejection.

In rejecting claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41, the Final Office Action alleged that the phrase "a quantity of product" is indefinite. See Final Office Action, page 5. In response, and without conceding to the Final Office Action's allegations, Applicant amends independent claim 1, with similar amendments to independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41, to recite "determining, based on searching the database, if the quantity of the product associated with the return request included in the second record matches a quantity of the product received at the warehouse," as indicated herein. These amendments overcome the rejection under 35 U.S.C. § 112, second paragraph, and Applicant requests withdrawal of the rejection.

III. Rejections under 35 U.S.C § 103(a)

Applicant respectfully traverses the rejection of claims 1-6, 9-36, and 40-47 under 35 U.S.C. 103(a) as allegedly being unpatentable over Hauser in view of Bloom. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103

is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established, for at least the reasons that the Office has neither properly determined the scope and the content of the prior art nor ascertained the differences between the prior art and the claimed combinations.

Amended claim 1 calls for a combination including, for example

splitting the second record into a plurality of new records, the plurality of new records including the RAN and having different statuses, when the quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse

(emphasis added). Hauser and Bloom, whether viewed alone or in combination, fail to teach or suggest at least the above-quoted features as recited in amended independent claim 1, and similarly recited in amended independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41.

The Final Office Action admitted that Hauser does not disclose “splitting/dividing the record into a plurality of new records/files with the RAN/or identification number for the return product based on the comparison,” but asserted that Bloom discloses this feature. See Final Office Action, pages 9-10. Even if this assertion were correct, which Applicant does not concede, Bloom fails to cure the deficiencies of Hauser, discussed

above. That is Bloom, also, fails to teach or suggest “splitting the second record into a plurality of new records, the plurality of new records including the RAN and having different statuses, when the quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse,” as recited in claim 1, and similarly recited in claims 9, 13, 20, 21, 24, 31, 32, 40, and 41 (emphasis added).

Bloom discloses that “[I]n updating Order Detail records 1202 with Retailer Shipment Id’s, the program (312) can make adjustments to an Order Detail Record 1202 to partially fill an order” Bloom, ¶ [0099]. In these cases, “the program (312) creates a new Order Detail record 1202 by copying all the values of the existing record 1202, except for Quantity.” *Id.* (emphases added). In other words, all values included in each of Bloom’s new Order Detail Records, other than quantity, are the same as in the original Order Detail Record. Thus, the status indicated in each of Bloom’s new Order Detail records is the same. Accordingly, because each of Bloom’s new Order Detail records 1202 have the same status value, they cannot constitute the claimed “plurality of new records including the RAN and identifying different statuses,” as recited in amended claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41.

As set forth above, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed combinations and the prior art. Moreover, the Final Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combinations obvious in view of the

prior art. For at least these reasons, no *prima facie* case of obviousness has been established. The rejection of claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 under 35 U.S.C. §103 as being obvious from Hauser in view of Bloom is thus improper and should be withdrawn.

Dependent claims 2-6, 10-12, 14-19, 22, 23, 25-30, 33-36, and 42-47 also should be allowable at least by virtue of their respective dependence from base claims 1, 9, 13, 20, 21, 24, 31, 32, 40, or 41, as well as because they recite additional features not taught or suggested by the combination of Hauser and Bloom. Applicant therefore respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-6, 9-36, and 40-47.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-6, 9-36, and 40-47 in condition for allowance. Applicant submits that the proposed amendments to claims 1, 4, 6, 9, 13, 20, 21, 24, 31, 32, 40, and 41 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Applicant further submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain assertions or requirements

applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art reference cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 22, 2010

By:



Robert E. Converse, Jr.
Reg. No. 27,432